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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/898,853      | 07/25/97    | YAMAGISHI            | H 045980            |

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EXAMINER

MARLO, G

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

09/29/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/898853

Applicant(s)

Yamagishi et al

Examiner

George J. MARLO

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4/27/99 + 8/20/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-19 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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The proposed drawing amendments filed April 27, 1999 are not approved being inadequate for their purpose, since they do not illustrate every critical feature recited in claims 1-19, and are not consistent with all features claimed. For example, said amendments propose that the inner cover layer be labeled with a Shore D value greater than 45, but claim 4 requires said Shore D value to be equal to 45, or greater.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the each of the critical features now claimed but not apparent to the eye from the drawings must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of the invention is obscured by failing to illustrate every feature claimed on the drawings. Also, to avoid speculation and to make clear the invention, all Shore D values must be expressed in Shore C parameters which will also facilitate comparisons with prior art patents.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chikaraishi et al (838) or Cavallaro et al (191) each in view of Nakamura.

The latter reference renders it obvious to provide each of the primary reference golf balls with a cover having a Shore D hardness of 60, to provide improved impact resilience. Any other

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possible distinctions over said thus modified golf balls are deemed obvious arbitrary variants thereof simply to provide comparative examples, or an additional "cover coating" of decorative paint.

An interference cannot be declared until a claim has been found patentable to applicant's

It is also noted the no papers under 37 CFR 1.607 can be found in the file.

No claim is allowed.

Marlo/tnt

September 26, 1999

*George J Marlo*  
GEORGE J. MARLO  
PRIMARY EXAMINER  
ART UNIT ~~002~~  
3711